



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,993	06/26/2003	Bruce N. Rosenthal	002140-01	4516

7590 10/16/2007
David M. Ostfeld
Chamberlain, Hrdlicka, White, Williams & Martin
Suite 1400
1200 Smith Street
Houston, TX 77002

EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
----------	--------------

3625

MAIL DATE	DELIVERY MODE
-----------	---------------

10/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/606,993

Applicant(s)

ROSENTHAL, BRUCE N.

Examiner

Nicholas D. Rosen

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-22 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 5, 7, 9, 13, 15, 16, 17, 18, 19, 20, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the anonymous article, "What's in a Name Change? OfficeTempo Becomes Semprio," hereinafter "Semprio," in view of Vigoroso ("E-commerce Tackles Direct Production") and official notice. As per claim 1, "Semprio" discloses a process of purchasing goods and services comprising: (A) organizing a set of customers desirous of purchasing at least some of the goods and services, such customers taken from tenant organizations housed in a building structure to purchase from a central source, said organizing including arranging for communication between the provider of services and each of the set of customers by providing a purchasing service operated by the provider of services for computer controlled electronic communication (whole article); and (B) locating at least one supplier having at least some of the goods or services (ibid.; the multiple suppliers disclosed would inherently have to have been located). Vigoroso teaches: (D) receiving orders from the customers; (E) combining the customer orders to a consolidated order for the supplier;

Art Unit: 3625

(F) ordering the customer orders from the supplier; (G) paying the supplier for the customer orders; (whole article, especially the paragraph beginning "CC culls numerous orders"); and (I) receiving goods from the supplier; and, by implication, (J) distributing the goods to the customer(s) (whole article, especially the paragraph beginning "In addition to lower product costs"). Neither "Semprio" nor Vigoroso expressly discloses (H) charging the customers for their respective orders, but official notice is taken that it is well known to charge customers for their orders; as Vigoroso teaches making single payments to the suppliers, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to charge the multiple customers for their orders, for the obvious advantage of not going rapidly bankrupt.

Neither "Semprio" nor Vigoroso expressly discloses (C) transmitting the available goods or services of the supplier to the set of customers at prices set by the service provider, but official notice is taken that it is well known for middlemen to transmit available goods or services to customers at prices set by the service provider (e.g., catalogs of products available from merchants who are not the manufacturers of those products). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transmit the available goods or services of the supplier to the set of customers at prices set by the service provider, for the obvious advantages of letting customers know what was available and at what prices, and setting prices at a level enabling the service provider to make a profit.

As per claim 3, neither "Semprio" nor Vigoroso expressly discloses confirming delivery to the supplier, but official notice is taken that it is well known to confirm

delivery of products one has ordered, as by signing for them. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to confirm delivery to the supplier, for the obvious advantage of assuring the supplier of a record of delivery, should any question or dispute arise regarding the products.

As per claim 4, neither "Semprio" nor Vigoroso expressly discloses that step (J) includes confirming delivery to the customer, but official notice is taken that it is well known to confirm delivery to a customer who receives a product (e.g., "Would you sign for this, please?"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to confirm delivery to the customer, for the obvious advantage of obtaining a record of delivery, should any question or dispute arise regarding the products.

As per claim 5, "Semprio" discloses multiple suppliers (paragraph beginning, "Customers can buy goods and services"). Vigoroso teaches multiple suppliers, combining customer orders to consolidated orders for the multiple suppliers, ordering the customer orders from the suppliers, and paying the suppliers (whole article, especially the paragraph beginning "CC culls numerous orders"), and receiving goods from the suppliers (whole article, especially the paragraph beginning "In addition to lower product costs"). Hence, it would have been obvious to do all these for multiple suppliers, for the obvious advantage of bulk buying of various products and services desired by customers.

As per claim 7, "Semprio" does not disclose the step of producing a catalog of available goods and services and transmitting the available goods and services in the catalog to the set of customers at prices set by the service provider, but official notice is taken that it is well known produce catalogs of goods and/or services, and transmit them online. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to produce such a catalog and transmit the available goods or services of the supplier to the set of customers at prices set by the service provider, for the obvious advantages of letting customers know what was available and at what prices, and setting prices at a level enabling the service provider to make a profit.

As per claim 9, "Semprio" discloses a "purchasing site" and "web site" (paragraphs beginning "Customers can buy goods and services" and "Along with price discounts," respectively). Because the Web is part of the Internet, the electronic communication is therefore by Internet service.

As per claim 13, "Semprio" discloses that the customers are various "businesses" and "companies" (paragraph beginning, "Backed by GEN3 Partners"). Official notice is taken that "businesses" and "companies" are very often corporations; hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the customers to be various corporations, for the obvious advantage of profiting from sales to businesses organized according to a very common form of business organization.

As per claim 15, neither "Semprio" nor Vigoroso expressly discloses negotiating by the service provider with the supplier for the best pricing for volume, but official notice is taken that it is well known for negotiate for the best price. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the service provider to negotiate with the supplier for the best pricing for volume, for the obvious advantage of paying less to obtain the desired products.

As per claim 16, "Semprio" discloses multiple suppliers suited for supplying various needs of customers (especially the paragraph beginning, "Customers can buy goods and services"), implying that the suppliers have been located based on the assembled needs of the customers.

As per claim 17, "Semprio" does not disclose withholding the name of the supplier from the customer, but official notice is taken that it is well known to withhold the names of suppliers from customers. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to withhold the name of the supplier from the customer for the obvious advantage of preventing the customer from easily buying products directly from the supplier, depriving the service provider of the profits made as a middleman.

As per claim 18, "Semprio" discloses ordering the customer orders from the suppliers, with no indication of the service provider maintaining an inventory (whole article); Vigoroso teaches ordering the customer orders from the suppliers, and delivering the products to the customers, with no indication of the service provider

maintaining an inventory (three paragraphs beginning from, "CC culls numerous orders"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the process to be inventory free to the service provider, for the obvious advantage of the service provider not having the expense of maintaining a warehouse and inventory therein.

As per claim 19, "Semprio" discloses e-commerce by computer controlled electronic communication (whole article). "Semprio" does not specifically disclose that steps E, F, and G are performed by computer controlled electronic communication, but official notice is taken that it is well known for processing orders, ordering products from suppliers, and making payments to be done by computer controlled electronic communication (e.g., over the Internet). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for these steps to be done by computer controlled electronic communication, for the obvious advantages of not having to hire human beings to carry out these steps by hand, or the put up with the delays of transmitting orders and payments through the postal system, etc.

As per claim 20, "Semprio" does not disclose that the service provider solely sets the prices, but official notice is taken that it is well known for middlemen offering products to solely set the prices. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the service provider to solely set the prices, for the obvious advantage of setting prices at a level expected to optimize the service provider's profits.

As per claim 21, neither "Semprio" nor Vigoroso teaches that the step (G), paying the supplier for the customer orders, is performed after (D) receiving orders from the customers, but before (E) combining the customer orders to a consolidated order for the supplier. However, in accordance with *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946), selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results, and there is no indication that paying the supplier for the customer orders before combining the customer orders to a consolidated order for the supplier achieves any new or unexpected results. Hence, it is held to be a trivial and obvious variation on the teachings of "Semprio" and Vigoroso.

As per claim 22, "Semprio" disclose the service provider providing customer service by which customers can fulfill their desires for various products and services (whole article).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Semprio," Vigoroso, and official notice as applied to claim 1 above, and further in view of Baljko ("Teledeal Web Site Acts as Buying Collective"). "Semprio" does not disclose that step (D) includes confirming the order, but not only is confirming orders well known in general, but Baljko teaches buyers receiving confirmation for their orders while suppliers receive combined orders (see especially the paragraph beginning, "While suppliers receive"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for step (D) to include confirming the order, for the obvious advantage of assuring the customers that their

orders have been received, and they need not attempt to purchase the goods elsewhere.

Claims 6, 8, 10, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Semprio," Vigoroso, and official notice as applied to claim 1 above, and further in view of Wong (U.S. Patent Application Publication 2002/0087349). As per claim 6, Semprio does not disclose organizing a limited set of customers desirous of purchasing at least some of the goods or services, such customers taken from tenant organizations housed in building structures to purchase from a central source, except in the sense that tenants of Brookfield Properties, and perhaps the tenants of other landlords, are limited to much less than the whole population of the world. Wong teaches providing services, including negotiating with vendors for tenants' needs using tenants' aggregated purchasing power, for an organized group of tenants limited to those of a particular service provider (Title; Abstract; Figures 1 and 2A; paragraphs 20-24). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to organize a limited set of customers desirous of purchasing at least some of the goods or services, such customers taken from tenant organizations housed in building structures to purchase from a central source, for the stated advantage of increasing the value of the property to tenants, and thus collecting higher rents.

As per claim 8, Wong teaches that the set of customers is a small closed set ("closed" since the set is limited to tenants of a particular property); this is taught by the

same parts of the Wong disclosure cited in rejecting claim 6 above, and element is obvious on the same grounds cited above.

As per claim 10, "Semprio" does not disclose that the communication is by restricted Internal portal, but official notice is taken that restricted internal portals are well known (e.g., intranets or extranets). The system of Wong, where the provision of services to tenants of a particular property makes the property more valuable to tenants, provides a motive for such a restricted internal portal, as in the rejection of claim 6 above.

As per claim 11, "Semprio" does not disclose that the communication is by restricted Internal portal, the restricted internal portal being restricted to customers located in the building structure, but official notice is taken that restricted internal portals restricted to users in a building are well known (e.g., intranets). The system of Wong, where the provision of services to tenants of a particular property makes the property more valuable to tenants, provides a motive for such a restricted internal portal, as in the rejection of claim 6 above.

As per claim 14, "Semprio" does not disclose that the building structure is a single building, but Wong refers to the building structure as one building (ibid., especially paragraph 22, referring to "building 110"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the building structure to be a single building, as set forth in the rejection of claim 6 above, and also as an obvious consequence of not being readily able to raise the capital to construct or buy more than one building.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Semprio," Vigoroso, and official notice as applied to claim 1 above, and further in view of Wong (U.S. Patent Application Publication 2002/0087349) and Fulton et al. (U.S. Patent 6,182,052). "Semprio" does not disclose that the electronic communication is by restricted Internal portal, but official notice is taken that restricted internal portals are well known (e.g., intranets or extranets). "Semprio" does not disclose that the restricted internal portal has a link invisible to the customers in the building structure, but invisible links are known, as taught, for example, by Fulton (column 6, lines 12-18). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the electronic communication to be by restricted internal portal, as in the rejections of claims 6 and 10 above, and for the restricted internal portal to have an invisible link, for the obvious advantage of preventing the customer from easily buying products directly from the supplier, depriving the service provider of the profits made as a middleman.

Response to Arguments

Applicant's arguments filed July 31, 2007 have been fully considered but they are not persuasive. In accordance with Applicant's amendment and remarks, the "provider of services" is taken as not necessarily an Internet service provider, on which account the rejection previously made under 35 U.S.C. 112, first paragraph, has been withdrawn. The rejection of claim 8 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicant's amendment.

In response to Applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, Vigoroso's teaching of consolidating orders is well known; if Vigoroso's article had never been published, other articles and patents regarding demand aggregation, etc., could have been applied. Having had occasion to search for prior art on demand aggregation previously, Examiner is in a position to know this, without relying on knowledge gleaned only from the applicant's disclosure. Likewise, the ideas of charging customers for their respective orders, and of middlemen setting prices for what they sell, are quite well known, and did not first come to Examiner's attention in Applicant's disclosure.

Regarding claim 2 in particular, Applicant argues that the prior art does not show all the elements of claim 1, concluding that the "official notice" is inapplicable. Examiner replies that official notice may be taken and applied, and Applicant neither properly traverses Examiner's taking of official notice, nor presents any argument as to why the facts of which official notice was properly taken are insufficient to establish the obviousness, in context, of the limitations which "Semprio" and Vigoroso do not expressly disclose.

Regarding claims 6, 8, 10, 11, and 14, Applicant merely asserts that Wong is inapplicable, although Wong is closely analogous art. Applicant notes that Applicant filed less than one year after the publication of Wong's Published Application. Examiner replies that there is no requirement for a prior art publication to have been published more than a year before an applicant's filing date, unless a rejection be made under 35 U.S.C. 102(b). There are other sections of 102, making a publication valid prior art if was published at all before an application, and that does not even take into account priority under 102(e) from the filing date of Wong.

Regarding claim 12, Applicant makes, in essence, a mere assertion of allowability.

The Supreme Court has ruled in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007) that the teaching, suggestion or motivation test should not be applied as a rigid and mandatory formula that limits obviousness analysis through a formalistic conception of the words "teaching," "suggestion," and "motivation" or by overemphasis on the importance of published articles and explicit content of issued patents, since market demand, rather than scientific literature, often drives design trends, and granting patent protection to advances that would occur "in the ordinary course" without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility (1385-1386).

To quote further from *KSR* (at 1386), “[R]igid application of preventative rules that deny fact finders recourse to common sense are neither necessary nor consistent with precedent.”

The Court also noted in the *KSR* decision, “[I]f there is design need or market pressure to solve [a] problem, and there are [a] finite number of identified, predictable solutions, [a] person of ordinary skill in art has good reason to pursue known options within his or her technical grasp, and if this leads to anticipated success, it is likely product of ordinary skill and common sense, not innovation.”

Applicant is advised to consider the applicability of the *KSR* decision to his claims, should he wish to prosecute them further.

The common knowledge or well-known in the art statements in the previous office action are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER
October 12, 2007